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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,076	10/06/2003	Thomas Bell	36-02	9942
23713	7590	10/06/2006	EXAMINER	
GREENLEE WINNER AND SULLIVAN P C 4875 PEARL EAST CIRCLE SUITE 200 BOULDER, CO 80301			COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/680,076

Applicant(s)

BELL ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14, 24 and 29-60 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/25/05, 7/27/06</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 14, 24 and 29-60 are pending in the application.

#### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on January 23, 2006 and the election of the species filed on July 27, 2006 are acknowledged. The traversal is on the ground(s) that it is believed that the application contains generic claims that are allowable which serve as a proper linking claims for the various species. This is not found persuasive because the method of use of the compounds of the formula embrace a wide variety of macrocyclic ring systems, including 1,5,9-triazacyclododecane, 1,4,7-triazacyclotetradecane, etc.

Note MPEP 2173.05(h) "where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression. Therefore, what should be considered for patentable distinctness is the compound as a whole. Would a whole compound where the compound is a 1,5,9-triazacyclododecane compound be patentably distinct from a whole compound where the compound is a 1,4,7-triazacyclotetradecane, etc.? If a reference for one would not be a reference for the other, then restriction is considered proper. It is the compound as a whole an 1,5,9-triazacyclododecane, 1,4,7-triazacyclotetradecane, etc., that must be considered for patentable distinctness.

Thus, separate searches in the literature would be required. However, should applicant traverse on the ground that the species are not patentably distinct, applicant

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should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 14 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 27, 2006.

#### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 29-38, 40-42 and 58-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

HOW TO MAKE: In evaluating the enablement question, several factors are to be considered. In re Wands, 8 USPQ2d 1400 (Fed. Cir. 1988); Ex parte Forman, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

The nature of the invention in the instant case, has claims which embrace substituted triaza compounds. The instant compounds of the formulae wherein a, b, c and d are repeating groups for the carbon atom which they are associated with in addition to e which is associated with a variable in itself forms a wide ring of possible ring systems with the smallest possibility being a triazole on up. The magnitude of possible ring systems are not described in the disclosure in such a way the one of ordinary skill in the art would no how to prepare the various compounds suggested by claims 29-38, 40-42 and 58-60. For example where are the starting materials for the preparation of compounds where the triaza ring is a 1,4,7-triazacyclotetradecane ring. In view of the lack of direction provided in the specification regarding starting materials, the lack of working examples, and the general unpredictability of chemical reactions, it

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would take an undue amount of experimentation for one skilled in the art to make the claimed compounds and therefore practice the invention.

5. Claims 29-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

HOW TO USE: Claims 29-60 are to "a method of treating an individual suffering from a pathological conditions which is ameliorated by suppression of CD4+-T-cell-mediated immune response". Any evidence presented must be commensurate in scope with the claims and must clearly demonstrate the effectiveness of the claimed compounds. However, the specification provides no definitive evidence to correlate any one disorder selected from those disclosed in the specification with the instantly disclosed triaza compounds.

No screening protocol(s) are ever described. Thus, no evidence of in vitro effectiveness is seen in the specification for one of the instantly claimed triaza compounds. In general, pharmacological activity is a very unpredictable area. In cases involving physiological activity "the scope of the enablement obviously varies inversely with the degree of unpredictability of the factors involved." In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970). Since this case involves unpredictable in-vivo physiological activities, the scope of the enablement given in the disclosure presented here was found to be low.

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The specification does not have working examples on the use of the substituted triaza compounds. The absence of working examples is one of the factors to be considered in deciding whether the practice of an invention would involve undue experimentation. There must be evidence to justify the contention that the claimed compounds can be useful in the treatment of "autoimmune disorder, chronic inflammatory disease, graft-versus host disease, transplant rejection, rheumatoid arthritis, type 1-diabetes mellitus, autoimmune demyelinating diseases such as multiple sclerosis, inflammatory bowel disease syndrome, psoriasis, discoid lupus erythematosus, systemic lupus erythematosus (SLE), adult respiratory distress syndrome, cardiovascular atherosclerosis, leukocytosis or asthma".

Where the utility is unusual or difficult to treat or speculative, the examiner has authority to require evidence that tests relied upon are reasonably predictive of in vivo efficacy by those skilled in the art. See *In re Ruskin*, 148 USPQ 221, *Ex parte Jovanovics*, 21 1 USPQ 907, MPEP 2164.05(a).

Patent Protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the mere germ of an idea does not constitute enabling disclosure. *Genentech Inc. v. Novo Nordisk* 42 USPQ2d 1001.

6. Claims 29-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. The definition of substitution includes several moieties, i.e. -CN, -SO<sub>3</sub>, -S-OR and NHR which are not described in the specification with respect to the formula.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 29-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

a) Claims 29, 31-39, 41, 42 and 58-60 are vague and indefinite in that it is not known what is meant by an alkyl group "carrying a charged substituent".

There is no indication in the claims what the counter ion would be.

b) Claim 29 is vague and indefinite in that it is not known what is meant by the capital letter in the fifth line on page 8, i.e. Optional. Capital letters are only to be used at the beginning of the claim and in variables for chemical cases.

c) Claims 29-60 are vague and indefinite in that it is not known what is meant by alky in the definition of R on page 8, line 8; page 8, line 3 of claim 30;.

d) Claims 29-60 are vague and indefinite in that it is not known what is meant by the two different definitions of R. R is defined on page 7, lines 11-14 and again on page 8, lines 8-9.

e) Claims 29-60 are vague and indefinite in that it is not known what is meant by "one or more polar groups" in the definition of the labeled "C" of the formula, i.e. page 8, line 15.

f) Claim 46 is vague and indefinite in that it is not known what is meant by the moiety  $-\text{SO}_2$ , which is a divalent moiety, however, there is only one point of attachment.

g) Regarding claim 60, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

h) Claims 29-60 are vague and indefinite in that the claim provides for the use of claimed compounds, but the claim does not set forth any steps involved in determining which are the disorders capable of being treated by ameliorated by suppression of CD4+-T-cell-mediated immune response. Determining whether a given disease responds or does not respond to such an inhibitor will involve undue experimentation. Suppose that a given drug, which has inhibitor properties in vitro, when administered to a patient with a certain disease, does not produce a favorable response. One cannot conclude that specific disease does not fall within this claim. Keep in mind that:

A. It may be that the next patient will respond. No pharmaceutical has 100% efficacy. What success rate is required to conclude our drug is a treatment? Thus, how many patients need to be treated? If "successful treatment" is what is intended, what criterion is to be used? If one person in 10 responds to a given drug, does that mean that the disease is treatable? One in 100? 1,000? 10,000? Will the standard vary depending on the current therapy for the disease?

B. It may be that the wrong dosage or dosage regimen was employed.

Drugs with similar chemical structures can have markedly different pharmacokinetics and metabolic fates. It is quite common for pharmaceuticals to work and or be safe at one dosage, but not at another that is significantly higher or lower. Furthermore, the dosage regimen may be vital --- should the drug be given e.g. once a day, or four times in divided dosages? The optimum route of administration cannot be predicted in advance. Should our drug be given as a bolus iv or in a time release po formulation. Thus, how many dosages and dosage regimens must be tried before one is certain that our drug is not a treatment for this specific disease?

C. It may be that our specific drug, while active in vitro, simply is not potent enough or produces such low concentrations in the blood that it is not an effective treatment of the specific disease. Perhaps a structurally related drug is potent enough or produces high enough blood concentrations to treat the disease in question, so that the first drug really does fall within the claim. Thus, how many different structurally related inhibitors must be tried before one concludes that a specific compound does not fall within the claim?

D. Conversely, if the disease responds to our second drug but not to the first, both of which are inhibitors in vitro, can one really conclude that the disease falls within the claim? It may be that the first compound result is giving the accurate answer, and that the success of second compound arises from some other unknown property, which the second drug is capable. It is common for a drug, particularly in analgesics, to work by many mechanisms. The history of

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psychopharmacology is filled with drugs, which were claimed to be a pure receptor XYX agonist or antagonist, but upon further experimentation shown to affect a variety of biological targets. In fact, the development of a drug for a specific disease and the determination of its biological site of action usually precede linking that site of action with the disease. Thus, when mixed results are obtained, how many more drugs need be tested?

E. Suppose that our drug is an effective treatment of the disease of interest, but only when combined with some totally different drug. There are for example, agents in antiviral and anticancer chemotherapy, which are not themselves effective, but are effective treatments when the agents are combined with something else.

Consequently, determining the true scope of the claim will involve extensive and potentially inconclusive research. Without it, one skilled in the art cannot determine the actual scope of the claim. Hence, the claim is indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 29-60 are rejected under 35 U.S.C. 102(a) as being anticipated by BELL et al., 15<sup>th</sup> International Conference on Antiviral Research. Bell teaches the method of


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use of the 1,5,9-triazacyclododecane compounds of the instant invention as shown by Figures 1, 5 and 6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Brenda L. Coleman  
Primary Examiner Art Unit 1624  
September 29, 2006